UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/581,992	01/02/1996	FRANK J. PELLEGRINO		7356

7590 12/23/2003

ROBERT W FLETCHER
10503 TIMBERWOOD CIRCLE
SUITE 114
LOUISVILLE, KY 40223

EXAMINER	
KAZIMI, HANI M	
ART UNIT	**PAPER NUMBER**
3624	

DATE MAILED: 12/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	08/581,992	PELLEGRINO ET AL.	
	Examiner	Art Unit	
	Hani Kazimi	3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondenc address --

Period f r Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 October 2003*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

1. This communication is in response to Applicant's amendment filed on October 6, 2003.

Status of Claims

2. Of the original claims 1-18, and the added claim 19, claims 1, and 11 have been amended by Applicants' amendment filed on December 21, 1998. In the amendment filed on October 6, 2003, claim 19 has been canceled. Therefore, claims 1-18, are under prosecution in this application.

Response to Applicants' Amendment

3. The Examiner acknowledges Applicants' cancellation of claim 19, and therefore withdraws the previous office action's objection regarding this matter.

The Examiner acknowledges Applicants' arguments in the remarks regarding the rejection under 35 U.S.C. § 103 and deemed to be persuasive. Therefore, the Examiner withdraws the previous office action's rejection under 35 U.S.C. § 103. However, Applicants' remaining traversals are discussed under 35 U.S.C. § 101, and 35 U.S.C. 112, first paragraph.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. § 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-18, are rejected under 35 U.S.C. § 101 as discussed in paragraph 5, paper No. 21.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1-18 are rejected under 35 U.S.C. 112, first paragraph as discussed in paragraph 7, paper No. 21.

Response to Applicants' Amendment

8. Applicant's arguments filed October 6, 2003 have been fully considered but they are not persuasive. In the remarks, the Applicant argues in substance that;

a) "The board of appeals in considering the same objections under section 101 simply stated "The calculation of a score for determining probability of success in a lawsuit or for

determining the relative strength of undertaking commercialization of an Intellectual Property is clearly a tangible, useful and practical result, which is obtained by the instant claimed invention." The applicant contends that this statement says that the invention as claimed yields a useful concrete and tangible result as required not only under State Street Bank but under the AT&T vs. Excel Communications case both of which were cited by the Board.". "The examiner has not attempted to apply a new and novel interruption to the cited cases, consequently the Board's decision on patentability under 101 must stand.".

In response to a);

The Board's decision on patentability under 101 still stands. The rejection given in both the previous and present office actions under 35 U.S.C. § 101 is different than the rejection presented to the Board of Appeals. Claims 1-18 do not produce a "***concrete***" result in the "Method for determining the risk associated with licensing or enforcing intellectual property". The results (scores) in the present application do not produce ***concrete*** results, it is unclear how the present application expresses the use of the resulting score, and how is it used in representing a relative degree of strength associated with commercializing intellectual properties.

It is true that the calculation of a score for determining probability of success in a lawsuit or for determining the relative strength of undertaking commercialization of an Intellectual Property is clearly a tangible, useful and practical result as indicated by the Board. However, it is Applicant who contends that this statement says that the invention as claimed yields a useful **concrete** and tangible result. The present rejection was not whether the results are tangible, useful

and practical, the rejection is based on concreteness. Applicant's claimed invention is still short on any particular or specific direction or guidance in achieving the desired results and in providing a concrete result.

b) The examiner 112 rejection is flawed for several reasons. First references made to US Patent number 5,999,907 cited by the examiner in his most recent office action. That patent reflects the proper 112 standard. The applicant also points out to the examiner that the claims do not require any specific number of risk factors or risk categories be present to gain the advantage of the invention. Moreover in the modern-day era of high-speed computer calculating and Internet searching the investigation of 100 items is hardly an impossible task and certainly does not rise to the level of undue experimentation. In fact it is precisely the use of a computer which enables the invention to be practiced.. The applicant refers to figure 1 step 3. were a composite score is calculated. It is then subjected to a known or projected moral hazard adjustment to obtain a probable success factor. It is suggested by the applicant that the way to use a probable success factor when undertaking a lawsuit is readily apparent. A low probable success factor would bode against bringing a suit and a high probable success factor would contrariwise suggest bringing the lawsuit.

In response to b);

Any reference made by Applicant to US Patent No. 5,999,907 issued to Donner, and whether it complies with 112 standard is irrelevant. What's relevant is whether the present

application complies with 112 standard. Applicant's amendment still does not address specific issues raised by the Examiner with respect to the 112 rejection.

The level of undue experimentation is not whether a high-speed computer can calculate or the Internet can be searched, it is how to the computer would be programmed, without undue experimentation, to convert text and essay questions and responses into computer data and in order to take into account all of theses subjective risk factors which the calculation process appears to entail.

Using moral hazard adjustments to obtain a probable success factor are known in the art. However, the instant specification is replete with generalizations regarding the various factors to be taken into consideration, it is short on any specific direction or guidance as to actually gathering the necessary data, inputting the required data and programming a computer to achieve the desired results.

In response to Applicant's statement that "a low probable success factor would bode against bringing a suit and a high probable success factor would contrariwise suggest bringing the lawsuit.", it is unclear from Applicant's disclosure to what is considered low and what is considered high probable success factor. There is no indication in the specification of how the composite score is used to evaluate the strength of a specific intellectual property nor how the probable success factor is used in undertaking a lawsuit, the actual step of evaluating the strength of an intellectual property using the score is not performed.

Conclusion

9. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hani Kazimi whose telephone number is (703) 305-1061. The examiner can normally be reached Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (703) 308-1065.

The fax number for Formal or Official faxes and Draft or Informal faxes to Technology Center 3600 or this Art Unit is (703) 305-7687 or 7658.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113 or 1114.

Hani.Kazimi

Art Unit 3624

December 20, 2003